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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,141	07/13/2004	Richard B. Mansfield Jr.	PIP114MANSPCTUS	5336
31518	7590	12/02/2008		
NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			NOTIFICATION DATE 12/02/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/501,141	Applicant(s) MANSFIELD JR., RICHARD B.	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5,10,12-23 and 52-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5,10,12-23 and 52-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/22/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the papers filed 8/1/2008.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 3, 5, 10, 12-23, 52-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knegendorf et al (US20030074272) in view of Abreu (20010056359).**

4. Regarding claims 3, 12, 55, Knegendorf et al teaches an automated online system for matching recall specifications with registered consumers [abstract, 0054, 0072]. Knegendorf et al does not teach that a consumer's actual purchase history is used as part of the way to match users to new recalls. However, Abreu teaches that users are identified at the POS and product identifiers for each purchase are electronically tracked so that if a recall for that particular product is identified/crated, the user can easily be associated with the recall and notified [0171]. It would have been obvious to one of ordinary skill at the time of the invention to have identified and tracked which consumers purchase which products so that when a recall is needed, the consumers who have purchased the affected product may be easily notified. Knegendorf et al teaches that consumers may be notified of the recall information in

various ways including by sending relevant recall information to the consumer's email address [0054] or the users may access the system to acquire recall information by telephone [0055], by logging into a personalized portal user interface [0053] or "in-person" access [0059]. Knegendorf et al does not appear to explicitly mention a terminal or kiosk of a retail store computer system, yet it would have been obvious to one of ordinary skill at the time of the invention to have provided in-store kiosks and/or terminals for consumers to access the system so that consumers without a home computer can access the recall information, or so that any consumer can check recall information while they are in the store. Knegendorf et al teaches that product recalls have been known to typically include exchange for a safer version of the product, or monetary compensation [0004], but Knegendorf et al does not explicitly state rebate or discount incentive options. However Official Notice is taken that it is notoriously well known that consumers who purchase recalled products were compensated with either vouchers (discount incentives) good for future purchase of a similar (yet safe) product or rebates refunding consumers for money spent on replacement (safe) versions of the product. It would have been obvious to one of ordinary skill at the time of the invention to have offered such options within the automated recall system of Knegendorf et al in view of Abreu so that consumers can be fairly made whole for the recalled product – either by known rebate techniques or discount voucher techniques.

5. Regarding claim 5, Abreu teaches the use of UPC codes and it would have been obvious to one of ordinary skill at the time of the invention to have used UPC codes to identify particular products,

6. Regarding claim 10, properly notifying a user about a recall and the requisite fulfillment is taken to include inclusion of a refund, rebate or incentive where that particular recall includes that type of fulfillment. Nonetheless, it would have been obvious to one of ordinary skill at the time of the invention to have for example included with the recall notice a rebate for a replacement product, so that the user can properly replace the recalled product.

7. Regarding claim 13, Knegendorf et al teaches that the system may be implemented with several servers [0039] and it would have been obvious to one of ordinary skill at the time of the invention to have a server dedicated to managing the matching recalls and a server dedicated to delivering the notices. Knegendorf et al also teaches that manufacturers can hire 3rd party fulfillment services [0006] and it would have been obvious to one of ordinary skill at the time of the invention to have forwarded the collection of affected users (i.e. userIDs) to an entity capable of effectively carrying out the fulfillment.

8. Regarding claim 14, Knegendorf et al teaches that the “manufacturer” can be a retailer [0037], and therefore a system that notifies the manufacturer of users associated with its recall can be said to be a system that notifies a retailer.

9. Regarding claim 15, it would have been obvious to one of ordinary skill at the time of the invention to have provided the consumer with a form letter customized with his name, userID, etc as is well known. It is also well known to include barcodes with documents so that they may be processed effectively which would have been obvious

with that of Knegendorf et al and Abreu so as to effectively track the recall and fulfillment.

10. Regarding claims 16, 21, it would have been obvious to one of ordinary skill at the time of the invention to have accounted for returns and costs of the recall as businesses are generally accountable for their financial reports as well as reports to industry groups, government, taxation entities, etc. See ¶ 0032. It is only a matter of good business sense to keep track of a businesses financial records and product flow.

11. Regarding claims 17-19, it would have been obvious to one of ordinary skill at the time of the invention to have entered a userID into a computer upon fulfillment so that the user cannot again try to fraudulently get more free products. It would have been obvious to one of ordinary skill at the time of the invention to have enabled returns of products at the POS as this is a typical place where consumers return merchandise. Official Notice is taken that returning recalled products by mail is a well known means for requesting replacement and it would have been obvious to one of ordinary skill at the time of the invention to have sent and received products via registered mail so that the postal facility can track shipments for better recordkeeping.

12. Regarding claim 20, 21, Knegendorf et al teaches that it is known to calculate effectiveness of recalls [0006] and it would have been obvious to one of ordinary skill at the time of the invention to have do so with that of Knegendorf et al in view of Abreu. Further, it would have been obvious to one of ordinary skill at the time of the invention to have paid a 3rd party fulfillment service according to how many products they had to process as part of the recall project.

13. Regarding claims 22, 23, any notice sent to a consumer is taken to be “marketing”, even recall notices. Further however, Knegendorf et al teaches the value in the collected consumer information with such a system [0030, 0034]. It would have been obvious to one of ordinary skill at the time of the invention to have send marketing information to the consumers of Knegendorf et al so that such “new products” can be marketing to those consumer interested in the types of products. Knegendorf et al also teaches keeping track of which notices a consumer sees and how often they re-visit those messages [0046]. It would have been obvious to one of ordinary skill at the time of the invention to have sent repeat recall notices to unfulfilled consumers , especially where the product defect is a serious or deadly one.

14. Regarding claims 52-54, 56-58, Knegendorf et al teaches that the computer system may link the consumers to fulfillment companies such as via HTML to fulfillment websites [0092]. It would have been obvious to one of ordinary skill at the time of the invention to have accomplished the well known fulfillment (offer and reconcile a rebate where proof of purchase is shown, or provide/generate/output a discount voucher for a future product purchase) through the automated computers system set forth by Knegendorf et al. In this manner, consumers can be made whole through automated fulfillment – providing fulfillment convenience in the same spirit that Knegendorf et al provides convenient and automated recall notifications.

Response To Arguments

Applicant argues that while Knegendorf et al recognizes typical recall fulfillment through monetary compensation, he fails to teach rebates or discount incentives. However as stated above, offering rebates for proof of purchases of alternative (safe) products is well known. Also well known is the concept of offering a discount voucher for a future alternative (safe) product purchase. It would have been obvious to one of ordinary skill at the time of the invention to have offered such options to the consumers of Knegendorf et al/Abreu within the automated recall systems therein.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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